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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 06/14/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/857,182

Applicant(s)

ANTON ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***WITHDRAWN REJECTIONS***

1. The 35 U.S.C. 112 rejections of claim 5 of record in Paper #7, Pages 3 – 4, Paragraph 9 have been withdrawn due to Applicant's amendment in Paper #9.

### ***REJECTIONS REPEATED***

2. The obviousness double patenting rejection is repeated for the reasons previously of record in Paper #7, Page 2, Paragraphs 1 – 4.
3. The objection to the Specification of record in Paper 3, Pages 2 – 3, Paragraphs 5 – 7 is repeated for the reasons previously stated since no sections heads are present.

### ***NEW REJECTIONS***

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the core contains from 2 to 45% by weight" in claim 11 is unclear, which

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renders the claim vague and indefinite. It is unclear from the claim language makes up 2 to 45% by weight of the core. For the purpose of examination, it is assumed to be 2 to 45% of xonotlite.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8 – 10 and 13 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kratel et al. (USPN 5,556,689) in view of Sklarski et al. (USPN 4,783,365).

Kratel et al. discloses a microporous heat insulating board with a thickness between 10 to 15 mm (Column 3, lines 14 – 16) that contains 30 to 100% by weight of finely divided metal oxide, 0 to 50% by weight of an opacifier, 0 to 15% of an organic binder and 0 to 50% by weight of a fibrous material (Column 4, claim 1). However, Kratel et al. fails to disclose at least one or both sides of the core having a cover of a heat-resistant material, characterized in that the cover are the same or different and at least one side consists of prefabricated mica sheets, the cover consists of a prefabricated mica sheet on both sides, the cover is adhered to the core and the cover and the core are heat sealed within a sheet.

Sklarski et al. teaches binder being impregnated in a mica paper or papers (Column 1, lines 47 – 52) before placed under heat and pressure (Column 6, lines 33 – 35) in a laminate for the purpose of forming a insulating structure with excellent flexibility, higher moisture resistance

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and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a layer of mica sheets as cover sheets in Kratel et al. in order to forming a insulating structure with excellent flexibility, higher moisture resistance and more strength that can be used as supporting insulation for high temperature thermostats, control devices, strip heaters and baseboard heaters as taught by Sklarski.

Kratel et al. ('689) discloses the claimed invention except for the thickness range of the core. However, Kratel et al. teaches a thickness of 10 to 15 mm, thus it would have been obvious to one having ordinary skill in the art at the time the invention was made to have the change the thickness of the core depending upon the end use of each product, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Regarding the cover being adhered or heat sealed to the core in claims 15 and 16, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of adhering or heat sealing is a method of production and therefore does not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of

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patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

8. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kratel et al. (USPN 5,556,689) in view of Sklarski et al. (USPN 4,783,365) as applied to claims 8 – 10 and 13 - 16 above, and further in view of Takahashi et al. (USPN 4,647,499).

Kratel et al., as modified with Sklarski et al., discloses the claimed invention above except for the heat insulation body being characterized in that it contains from 2 to 45% or 5 to 15% by weight of xonotlite.

Takahashi et al. teaches 2 to 60% (Column 7, lines 30 – 34) of xonotlite (Column 21, lines 59 – 61), 21 to 70% of an inactive substance (Column 5, lines 53 – 55) which includes metal oxides (Column 5, lines 31 – 40) and other additives such as fibers and binders (Column 7, lines 51 – 53) in an insulation board for the purpose of forming a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the xonotlite as a component in Kratel et al. in order to form a board that is light weight, has excellent insulating properties over a wide range of temperatures and has high fire resistance as taught by Takahashi et al.

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***ANSWER TO APPLICANT'S ARGUMENTS***

9. Applicant's arguments filed in Paper #9 regarding the 35 U.S.C. 103 rejections of claims 1 – 7 have been considered but are moot since the claims have been cancelled and new art rejections have been applied.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Monday thru Friday from 8:15 a.m. until 4:45 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

June 11, 2002

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
*1772*

*6/11/02*